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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,643	08/30/2001	Louis Benoit	P21366	7042

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EXAMINER

PHAN, HAU VAN

ART UNIT PAPER NUMBER

3618

DATE MAILED: 07/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/941,643

Applicant(s)

BENOIT, LOUIS

Examiner

Hau V Phan

Art Unit

3618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/377,841.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 3618

## **DETAILED ACTION**

### ***Acknowledgment***

1. The request for extension of time had been considered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase "non-circular boss" and "said boss having an outline devoid of a straight line" are not described in the specification.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

Art Unit: 3618

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-5, 7-12, 14-21, 24-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-43 of U.S. Patent No. 6,293,563. Although the conflicting claims are not identical, they are not patentably distinct from each other because a foot-bearing, lateral and medial flange and a stiffening rib had been set forth in claims 1-43 of '563. The stiffening rib has a pair of opposite ends, an intermediate portion extending longitudinally between the opposite ends. The intermediate portion extending longitudinal along the at least one flange other than in a single straight line between the opposite ends at a higher elevation relative a straight line connecting the opposite ends had been claimed in the previous claims of the patent number 6,293,563.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3618

7. **Claims 1-5, 7-16, 18-22 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myers et al. (5,735,536) in view of MacDonnell (1,977,587).**

Myers et al. in figure 2 discloses a chassis (10) for an in-line skate. The chassis comprises at least one substantially horizontal foot bearing portion (15), one longitudinally extending lateral flange (26) extending downwardly from the foot-bearing portion. Myers et al. also discloses one longitudinally extending medial flange (25) extending downwardly from the foot-bearing portion. Each of the lateral flange and the medial flange has a top portion and a bottom portion. Wherein both the top portions of the lateral flange and the medial flange being transversely spaced apart and both the bottom portions of the lateral flange and the medial flange being adapted to have attached therebetween at least one wheel. Myers et al. further discloses a stiffening rib (32), which is made by pressing. Myers et al. fails to show the stiffening rib extending longitudinally other than in a straight line.

MacDonnell in figure 4 discloses a chassis having a stiffening rib (10) extending longitudinally other than in a straight line. The rib comprises opposite ends (H, I, see attached figure 4) and being continuous between opposite ends. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the chassis of Myers et al. with the improvement of the stiffening rib as taught by MacDonnell in order to have attractive appearance peculiar to the chassis.

Regarding claim 3 Myers et al. discloses a cut-out (33) in at least one of the lateral flange and the medial flange.

Art Unit: 3618

Regarding claims 4-5, Myers et al. discloses a stiffening rib (32) projecting outwardly, but fails to show the rib projects inwardly. It would have been a design choice to have the rib projecting outwardly or inwardly.

Regarding claim 13, Myers et al. discloses a top portion of each of the lateral and medial flanges, which is adjacent to the foot-bearing portion (figure 3).

Regarding claims 14-15, MacDonnell in figure 3 discloses a stiffening rid (10) of a lateral flange (4) having an end extending downwardly toward an end of the lateral flange. The stiffening rib of a medial flange (5) has an end extending downwardly toward an end of the medial flange. Wherein the stiffening rid of the lateral and medial flanges have longitudinally extending curved shapes downwardly facing concavity.

Regarding claim 16, MacDonnell discloses a stiffening rib (10) of the lateral and medial flanges having a longitudinal portion intermediate of opposite ends. The intermediate portion has a higher elevation relative to the opposite ends (figure 3).

Regarding claim 18, Myers et al. discloses both of the lateral and medial flanges comprising means of attaching the at least one wheel to the lateral and medial flanges. The means arranged longitudinally along the lateral and medial flanges. Myers et al. also discloses stiffening rib, which are positioned above the means.

Regarding claim 19, MacDonnell discloses a stiffening rib (10) of the lateral and medial flanges having opposite ends and continuous between the opposite ends.

Regarding claims 20-22, Myers et al. discloses both of the lateral and medial flanges, foot-bearing portions, in transverse cross section comprising a substantially U-shape and formed as a single piece. Myers et al. also discloses at least one foot-

Art Unit: 3618

bearing portion comprising two longitudinally spaced apart foot-bearing portions and wherein the two longitudinally spaced apart foot bearing portions, the lateral flange and the medial flange are formed as a single piece.

Regarding claims 28-30, Myers et al. discloses the top portion of each of the lateral and medial flanges, which is adjacent to the foot-bearing portion. Myers et al. also discloses a plurality of holes (31, 35) for receiving axles of wheels adapted to be positioned between the lateral and medial flanges. Wherein bosses do not surround the holes and spaced from the holes. Myers et al. further discloses a plurality of in-line wheels mounted between the lateral and medial flanges.

8. <sup>are</sup> Claims 6 and 23-27 ~~is~~ rejected under 35 U.S.C. 103(a) as being unpatentable over Myers et al. (5,735,536) in view of Bourdeau (5,456,477).

Myers et al. in figure 2 discloses a chassis (10) for an in-line skate. The chassis comprises at least one substantially horizontal foot bearing portion (15), one longitudinally extending lateral flange (26) extending downwardly from the foot-bearing portion. Myers et al. also discloses one longitudinally extending medial flange (25) extending downwardly from the foot-bearing portion. Each of the lateral flange and the medial flange has a top portion and a bottom portion. Wherein both the top portions of the lateral flange and the medial flange being transversely spaced apart and both the bottom portions of the lateral flange and the medial flange being adapted to have attached therebetween at least one wheel. Myers et al. fails to show a boss having an outline devoid of a straight line.

Art Unit: 3618

Bourdeau in figure 3 discloses a skate with in-line wheel having a lateral flange (11A) and medial flange (11B). The lateral flange and medial flange have non-circular bosses (40, 41), which are made by pressing and having an outline devoid of a straight line (figure 3). The bosses in figure 3 are a semicircle, which are concentric to an axle (13) and lack of straight line. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the chassis of Myers et al. with the improvement of the boss as taught by Bourdeau in order to protect the flange against the wheel.

Regarding claims 23-27, Bourdeau discloses a top portion (figure 3) of each of the lateral and medial flanges, which is adjacent to a foot-bearing portion. The lateral and medial flanges have a plurality of holes (figure 3) for receiving axles of wheels adapted to be position between the lateral and medial flanges. Wherein bosses spaced from the holes. Bourdeau further discloses a plurality of in-line wheels (18) mounted between the lateral and medial flanges.

9. **Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Myers et al. (5,735,536) in view of MacDonnell (1,977,587) as applied to claim 1 above, an further in view of Meibock et al. (5,848,796).**

The combination of Myers et al. and MacDonnell disclose lateral and medial flanges having front and rear end portions, but fail to show the front and rear end extending forwardly and downwardly.

Meibock et al. in figure 1 discloses an in-line roller skate comprising lateral and medial flanges including front and rear end portions (figure 1). The front-end portion includes top and bottom edges extending forwardly and downwardly. The rear end

Art Unit: 3618

portion includes top and bottom edges extending rearwardly and downwardly. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the chassis of Myers et al. and MacDonnell with the roller skate as taught by Meibock et al. having lateral and media flanges having top and bottom edges extending forwardly, rearwardly and downwardly in order to provide both vertical support for both front and rear end portions.

### ***Response to Arguments***

10. Applicant's arguments filed 4/29/2002 have been fully considered but they are not persuasive. In response to applicant's arguments that the in-line skate of Myers et al. has a substantial cross section along a chassis length, thereby enabling the chassis to be manufactured by an extrusion process. Therefore, a longitudinally curved rib would not be possible. The examiner agrees, as MacDonnell discloses the chassis having a substantial cross section along the chassis length. The chassis of MacDonnell also has a longitudinally curved rib along the chassis length. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the chassis of Myers et al. based upon the teaching of the chassis shown by MacDonnell, thereby providing a longitudinally curved rib for greater stiffening of the chassis.

Art Unit: 3618

**Conclusion**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hau V Phan whose telephone number is 703-308-2084. The examiner can normally be reached on 7:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson can be reached on 703-308-0885. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 3618.

HP *HP*  
June 27, 2002

*Brian Johnson*  
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6/27/02